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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/471,160 | 12/23/1999 | SATOSHI KOKUBO | 35.C14155 | 7094 |

5514 7590 10/22/2002

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EXAMINER

MARKHAM, WESLEY D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1762

8

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/471,160

Applicant(s)

KOKUBO ET AL.

Examiner

Wesley D Markham

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Acknowledgment is made of applicant's amendment A, filed as paper #7 on 8/13/2002 (with a certificate of mailing dated 10/2/2001), in which the title of the instant application was amended, a new abstract of the disclosure was submitted, the specification of the instant application was amended, Claims 3 and 5 were canceled, and Claim 1 was amended. Claims 1, 2, and 4 are currently pending in U.S. Application Serial No. 09/471,160, and an Office Action on the merits follows.

Election/Restrictions

2. Applicant's election of Group I, Claims 1, 2, and 4, drawn to a coating method, in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The examiner notes that non-elected Claims 3 and 5 have been canceled by the applicant per amendment A.

Drawings

3. The objection to the drawings, set forth in paragraphs 8 – 9 of the previous Office Action, is withdrawn in light of applicant's amendment A in which reference number "66" was inserted into the specification.

Specification

4. The objections to the specification, including the title of the invention and the abstract of the disclosure, set forth in paragraphs 10 – 15 of the previous Office Action, are withdrawn in light of applicant's amendment A.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. The rejection of Claims 1, 2, and 4 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, set forth in paragraphs 17 – 18 of the previous Office Action, is withdrawn in light of applicant's amendment A. Specifically, amended independent Claim 1 no longer recites flowing the rinsing liquid from a point midway of a coating liquid supply path extending to the coating head.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 2, and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Specifically, amended independent Claim 1 (from which Claims 2 and 4 depend) requires in part, "...making a rinsing liquid flow to said coating head from a coating liquid supply path extending to said coating head". The language of this limitation renders the claims vague and indefinite. In light of the applicant's disclosure / specification, it is unclear how the rinsing liquid flows to the coating head from the coating liquid supply path. Is the applicant attempting to claim a process in which the rinsing liquid supply path is the same as the coating liquid supply path? This does not appear to be the case from the applicant's specification (see, for example, Figure 1). For the purposes of examination only, the examiner has interpreted the claims to require making a rinsing liquid flow to the coating head from a rinsing liquid supply path extending to said coating head in order to correspond to the applicant's specification.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
12. Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being anticipated by Asahi Glass Co Ltd. (JP 10-282329 A) for the reasons set forth in paragraphs 21 – 22 of the previous Office Action.
13. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Maneke et al. (USPN 4,704,308) for the reasons set forth in paragraphs 24 – 25 of the previous Office Action.
14. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Henninger (USPN 4,560,584) for the reasons set forth in paragraphs 27 – 28 of the previous Office Action.

15. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Poag et al. (USPN 5,958,517) for the reasons set forth in paragraphs 30 – 31 of the previous Office Action.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's admitted prior art (AAPA) in view of Asahi Glass Co Ltd. (JP 10-282329 A) for the reasons set forth in paragraph 34 of the previous Office Action.

19. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's admitted prior art (AAPA) in view of Poag et al. (USPN 5,958,517) for the reasons set forth in paragraph 36 of the previous Office Action.

Response to Arguments

20. Applicant's arguments filed on 8/13/2002 have been fully considered but they are not persuasive.
21. First, the applicant argues that Asahi teaches an ink jet head for pattern forming, not for a coating process. In response, Asahi teaches that the head discharges ink on a substrate to form a color filter (Abstract). This is a coating process as claimed by the applicant. Second, the applicant argues that Asahi does not teach rinsing the inside of the coating head like the present invention, but rinsing an end section of the ink jet. In response, the claims of the instant application do not require rinsing the inside of the coating head. However, even if the claims did require this limitation, Asahi would anticipate the claims. Specifically, Asahi teaches that the cleaning liquid is pumped inside the head, clearing the inner portion of the head of dirt and stains (Abstract).
22. Third, the applicant argues that both Maneke and Henninger relate to maintenance issues during extended interruption, while the present invention relates to cleaning in a continuous operation. In response, the applicant's claims do not require and are not drawn to cleaning in a "continuous operation". Both Maneke and Henninger

teach all the limitations of Claims 1 and 2 as set forth in paragraphs 23 – 28 of the previous Office Action and therefore anticipate the claims.

23. Fourth, the applicant argues that Poag is directed to a spinner and does not teach a nozzle for direct coating like the present invention. In response, the applicant's claims do not exclude coating by a spinning process and do not require "direct coating". Poag teaches all the limitations of Claims 1 and 2 as set forth in paragraphs 29 – 31 of the previous Office Action and therefore anticipates the claims.
24. Please note that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
26. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is

mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (703) 308-7557. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.
28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.
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29. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Wesley D Markham
Examiner
Art Unit 1762



WDM
October 17, 2002



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